UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON DC 20005

MAILED

FEB - 9 2005

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

In re Application of:
Hiroyuki Shibata, et al.
Application Serial No.: 09/760,883
Filed: January 17, 2001
For: **DISPLAY APPARATUS WITH REDUCED NOISE EMISSION AND DRIVING METHOD FOR THE DISPLAY APPARATUS**

DECISION
ON PETITION

This is a decision on the letters filed November 12, 2004, December 28, 2004 and petition filed January 28, 2005. Each of the aforementioned communications from applicant are treated as petition to the Director from an action of the examiner, pursuant to 37 CFR § 1.181.

Petitioner states in their November 12, 2004 communication that "Accordingly, withdrawal of the Finality of the Action mailed July 28, 2004 is mandated since premature, pursuant to MPEP 706.07(c) through 706.07(e), and the same accordingly should be withdrawn and a new, non-final Office Action issued, setting a new Response period based on the mailing date of same.

Petitioner in their December 28, 2004 communication, refers to the subject matter of the November 12, 2004 letter. A copy of the November 12, 2004 letter was supplied with the December 28, 2004 communication from applicant. In addition, the December 28, 2004 communication presented arguments as to the relevancy of the applied Kawakami reference.

Petitioner states in their January 28, 2005 communication that "The current Action of January 12, 2005 repeats identically the prior art rejections of the pending claims, as they were presented in the Action of July 28, 2004 – and, it follows, that the final rejection is premature for the identical reason that the July 28, 2004 final rejection was premature." Petitioner requests that the finality of the Office action be withdrawn. Petitioner refers to MPEP §706.07(a) and emphasizes the point that second or subsequent actions on the merits shall be final, **except** where an examiner introduces a new ground of rejection that is not necessitated by the Applicant's amendment of the claims.

A review of the file records reveals that:

A non-final Office action was mailed on December 12, 2003 wherein claims 1-2, 10, 14-15, 19, 23, 27-28 and 34-39 were rejected under 35 U.S.C. §103 as being obvious in view of Morrison. Claims 4, 8, 12, 17, 21, 25 and 30 were rejected under 35 U.S.C. §103 as being obvious over Morrison in view of applicant's admission of prior art. Claims 5, 9, 13, 18, 22, 26 and 31 were rejected under 35 U.S.C. §103 as being obvious over Morrison in view of Tanaka. Claim 6 and 40 were rejected under 35 U.S.C. §103 as being obvious over Jagdt. Claim 32 was rejected under 35 U.S.C. §103 as being obvious over Morrison in view of Nakata. Claim 33 was rejected under 35 U.S.C. §103 as being obvious over Morrison in view of Cooper. Claims 41-47 were rejected under 35 U.S.C. §103 as being obvious over Morrison in view of Jagdt. Claims 7, 11, 20 and 24 were indicated allowable and finally, claims 3, 16 and 29 were objected to.

On May 12, 2004 applicants submitted an amendment whereby certain dependent claims were cancelled and the word "plasma" was incorporated into the claim chain of the remaining claims.

On July 28, 2004, a final Office action was mailed whereby claims 3, 7, 11, 16, 20, 24, 29 and 48 through 52 were rejected under 35 U.S.C. § 112 1st paragraph. Claims 1-2, 10, 14-15, 19, 23, 27-28 and 34-39 were rejected under 35 U.S.C. §103 as being obvious in view of Kawakami. Claims 5, 13, 18, 22, 26 and 31 were rejected under 35 U.S.C. §103 as being obvious in view of Kawakami in view of Tanaka et al. Claim 32 was rejected under 35 U.S.C. §103 as being obvious over Kawakami in view of Nakata et al. Claim 33 was rejected under 35 U.S.C. §103 as being obvious over Kawakami in view of Cooper. Claims 41-47 were rejected under 35 U.S.C. §103 as being obvious over Kawakami in view of Jagdt. Claims 6, 9 and 40 were indicated as being allowable.

On November 12, 2004 and again on December 28, 2004, Applicant filed requests to have the July 28, 2004 finality of the Office action withdrawn, withdrawal of the Office action in its entirety and issuance of a new, non-final Office action setting a new response period.

In addition, the December 28, 2004 communication from applicant, presented arguments as to the applied 35 U.S.C. §112 1st paragraph rejection and also presented arguments with respect to the Kawakami reference, newly cited in the July 28, 2004 Office action.

On January 12, 2005, the Office mailed a new final Office action which maintained the same grounds of rejection, with the exception of the 112 1st paragraph rejection, as applied in the July 28, 2004 Office action.

With respect to applicant's November 12, 2004 request (re-submitted on December 28, 2004), to withdraw the Office action and issue a new non-final Office action, the request was filed not only outside two months from the action complained of as established by 37 C.F.R. §1.181(f), but also outside the shortened statutory time period for response to the outstanding Office action. Moreover, other than the appropriateness of the finality of the Office action, Petitioner did not provide appropriate justification why the Office action excluding the finality thereof, was improper under 37 C.F.R. §1.104. The issue of whether or not Petitioner agrees with the art applied to the claims, is not a petitionable matter but rather part of the examination process.

With respect to petitioner's November 12, 2004 request (re-submitted on December 28, 2004) to withdraw the finality of the July 28, 2004 Office action, the examiner, in accordance with MPEP §706.07(a) and (d), agreed with petitioner and withdrew the finality of the July 28, 2004 action as stated in the first section of the Office action mailed January 12, 2005.

Accordingly, the petition filed November 12, 2004 and re-submitted on December 28, 2004, is hereby **Granted in Part** to the extent that the finality of the July 28, 2004 Office action was withdrawn by the examiner in their next Office action, i.e., January 12, 2005.

The communication submitted December 28, 2004 not only re-submitted the request from November 12, 2004, but applicant also argued distinction between their claims and the applied Kawakami reference. Applicant requests: "Accordingly, we ask that you reconsider not only the premature Final rejection but also the irrelevance of Kawakami with respect to the invention defined by the pending claims of the present application."

37 CFR § 1.111. Reply by applicant or patent owner to a non-final Office action, states in part:
(a)

(1) If the Office action after the first examination (§ 1.104) is adverse in any respect, the applicant or patent owner, if he or she persists in his or her application for a patent or reexamination proceeding, must reply and request reconsideration or further examination, with or without amendment. See § § 1.135 and 1.136 for time for reply to avoid abandonment. [emphasis added]

The December 28, 2004 communication requested reconsideration of the action in which the Kawakami reference was applied. Given that Kawakami was the base reference for all claim rejections, applicants' December 28, 2004 communication was properly taken as a full and proper response to the outstanding Office action.

It is noted at this point that in order for the December 28, 2004 communication to be considered a timely submission, in order to avoid abandonment of the application, a two month extension of time was required. Attached to the December 28, 2004 reply was a copy of the November 12, 2004 letter, wherein applicant states: "If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935." Accordingly, applicants' deposit account has been charged for a two month extension of time. [emphasis added]

Finally, with respect to Petitioner's January 28, 2005 communication which requests that the final Office action mailed January 12, 2005, be withdrawn, first stated that the grounds of rejection was not a result of applicants' amendment. It is agreed that the examiner used the wrong form paragraph in communicating the holding of finality of the Office action. However, this does not mean that the finality of the January 12, 2005 Office action was improper. Merely, that the examiner used the wrong form paragraph in noting the finality.

In addition, the January 28, 2005 petition states that "The current Action of January 12, 2005 repeats identically the prior art rejections of the pending claims, as they were presented in the Action of July 28, 2004 - and. it follows, that the final rejection is premature for the identical reason that the July 28, 2004 final rejection was premature."

MPEP §706.07(a) [R-1] Final Rejection, When Proper on Second Action, states in part:..

> Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

It is argued that the January 28, 2005 final rejection is premature for the same reasons that the July 28, 2004 final rejection was premature. However, as acknowledged by applicants in their petition, the examiner maintained the same grounds of rejection as that set forth in the July 28, 2004 Office action, with the exception that the 112 1st paragraph rejection was not maintained.

Therefore, in accordance MPEP §706.07(a) the Office action was appropriately made final, i.e., the examiner did not introduce a new ground of rejection given that the same grounds set forth in the July 28, 2004 Office action, were maintained in the January 28, 2005 final Office action.

Accordingly, petitioner's request to withdraw the final Office action of January 28, 2005 is **Denied.**

The file is being forwarded to the Technology Center's Central Files to await Applicant's response to the outstanding Office action.

Leo Boudreau, Acting Director
Technology Center 2600
Communications